

9th Open Forum Lisbon, Portugal

2-5 November, 2005



Three parallel streams dealing with practical topics will be presented by experts in their fields.

TRADEMARK STREAM

Topics include spare parts enforcement in China, TM licensing

THE PATENT STREAM

includes discussions on nanotechnology, wilful infringement, and comparative claim drafting.

THE GENERAL STREAM

has been dedicated to Practice Management and has presentations on strategic planning, partnership and financial structures and risk management.



SPEAKERS INCLUDE:

Judge Michael Fysh - Patents County Court

Judge Paul Michel - CAFC

Adrian Otten - WTO

EU Commission

Ed Wesemann - Edge International

OPEN TO ALL

FICPI members, non-members, Intellectual Property practitioners, colleagues from industry.

IT IS YOUR OPPORTUNITY

to listen to and debate with the experts recent international developments in intellectual property protection and their impact on day-to-day practice.

The General Stream has been sponsored in part

by: **Managing Intellectual Property**

REGISTER ON-LINE NOW AT WWW.FICPI.ORG

9th Open Forum Lisbon, Portugal

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FICPI, the International Federation of Industrial Property Attorneys requests the pleasure of your attendance at its **Ninth Open Forum on Intellectual Property**.

This FORUM is more than just another conference. It is your opportunity to participate in and contribute to a meeting involving audience participation discussing a wide variety of issues.

This FORUM will be OPEN in many respects:

- FICPI is pleased to welcome from all regions of the world colleagues from industry as well as those in private practice - members of FICPI and non-members alike.

- The programme is in the "Multi-Choice" format:

The sessions have been arranged in three parallel streams relating to PATENTS, GENERAL ISSUES and TRADEMARKS.

The topics in each series have been chosen to be current, practical and relevant to day-to-day practice. We are confident that our programme will provide every IP practitioner with a presentation of interest at any time during the Forum.

You, the delegate, will have the choice to attend

during each session the seminar which is of most interest to you.

- Speakers at this FORUM will be practitioners from private practice and from industry, the legal profession, the Judiciary, official bodies, and academia. They are chosen for the expertise and insight they bring to the particular topic.

Less than a half of the time in each session will be devoted to formal presentation. Ample time will be available for questions, comments and discussions. Prepare your questions and comments.

- The fully inclusive programme ensures that you can meet your peers and exchange views on the rapidly changing intellectual property scene worldwide in informal gatherings - at the reception, over coffee and during lunches and dinners and the optional excursion.



WHAT IS FICPI . . .

FICPI is the acronym of the French title of our federation: Fédération Internationale des Conseils en Propriété Industrielle.

FICPI was created in 1906 as an association of intellectual property attorneys in private practice.

FICPI is a truly international organization, having members in over 80 countries around the world.

. . . AND WHAT ARE ITS AIMS?

FICPI is a non-political, international organization of the free profession with the principal aims:

- To enhance international co-operation within the profession of industrial property attorneys, promote the

exchange of information and harmonize and facilitate business relations between members.

- To maintain the dignity of its members and the standards of the profession of industrial property attorneys in private practice on an international scale.

- To express opinions with regard to newly proposed international and national legislation, in particular with respect to the maintenance and invigoration of the systems for industrial property protection. FICPI is regularly heard by international organizations, such as the World Intellectual Property Organization (WIPO), the European Patent Office (EPO), the Commission of the European Communities and the Council of Europe, enjoying observer status or advisory status with respect to such organizations.

- To promote training and continuing education of its members and others interested in Intellectual Property.

FORUM ORGANIZERS

ENIC srl, Congress & Travel Professionals

Piazza Adua 1 D, 50123 FIRENZE, ITALY

Contact: Chiara Ponticelli

email : chiara@enic.it

Tel. : +39-055-260 8941 Fax: +39-055-260 8948

OPEN FORUM EVENT & TOUR DESCRIPTIONS

November 2 - pm guided visit - optional

The tour will start at 14:30. Meeting point: level 1. Transfer by bus.

For the optional guided visit in the afternoon of November 2, we propose 2 choices:

A) the Ancient Art Museum, where we will learn about the best of Portuguese art through the centuries. One single masterpiece would already be worth this visit: the six "Panéis de São Vicente" made in the 15th century by Nuno Gonçalves, who is considered to be the first representative of Portugal national painting. But there is also much more to see: European art and also a notable collection of art of the many peoples with which the Portuguese got in touch over the centuries.

B) the Calouste Gulbenkian Museum: inaugurated in 1969, this purpose-built museum was created as part of the charitable institution bequeathed to Portugal by the Armenian oil magnate and multimillionaire, Calouste Gulbenkian. Housing his unique collection of art, the museum ranks as one of the finest in Lisbon. The exhibits, which span over 4.000 years from ancient Egyptian statuettes, through translucent Islamic glassware, to Art Nouveau brooches, are displayed in spacious and well-lit galleries, many of which overlooking beautiful gardens and terraces.

November 2 - Welcome cocktail - Corinthia Alfa hotel

- Participants and Accompanying Persons

The welcome cocktail of the FICPI 9th Open Forum will take place at the hotel and will be set in the "Tempus Lounge Bar" and surrounding area, with a view over the hotel terrace and the pleasant garden, where - weather permitting - the cocktail will be served too.

November 3 - Participants - Business session - Lunch in hotel

- Accompanying Persons - Guided tour "Treasures of art and architecture"

The tour will start at 9:30. Meeting point: level 1. Transfer from the hotel to the Ajuda Palace and visit of the last palace of the Portuguese kings, which was never finished. After the visit, we will continue by tram. From Estrela, the 7th hill of Lisbon, the little trams will bring us back to the origins of Lisbon: up and down the hills to reach S. Jorge Castle. We will have to walk the last hundred meters to get up to the terrace of the Castle, but the exceptional view will totally reward us.

Lunch will be served in a truly authentic Portuguese atmosphere at "Casa do Leão", a fine restaurant serving traditional Portuguese kitchen.

November 3 - Dinner at Kais restaurant

- Participants and Accompanying Persons

The reconversion of former industrial buildings is the hallmark of nowadays' Lisbon. To get in touch with this trend, we'll have dinner at "Kais", an old warehouse completely refurbished to make it one of the most interesting restaurants in town, a new and stylish space located in the trendy Docas (docks) waterfront area of the city.

The Kais' upper floor is a very modern loft with high ceiling and big arch shaped windows, while the lower floor is an Adega (wine cellar), with a more relaxed, cosy and informal atmosphere.

Notice: the upper floor maximum capacity is 400 persons; late registrants exceeding this number will be accommodated in the Adega.

November 4 - Participants - Business session - Lunch in hotel

- Accompanying Persons - Guided tour "Lisbon special tour"

The tour will start at 9:30. Meeting point: level 1. Transfer by bus. If you are crazy about gardens, Lisbon is the ideal place for you! Our visit will start at the Estufa Fria: long ago this former black stone quarry was transformed into a pleasant botanical garden. We will continue our tour through the Edward VII park, then travelling along the main avenue (Avenida da Liberdade) by bus, you will appreciate hundreds of sycamores together with monuments and remarkable buildings. We will then head in the direction of Belém where you will enjoy some very nice Mediterranean sights: orange and olive trees, surrounded by masterpieces as the famous Jerónimos Monastery. At last, visit of the Botanical garden of Ajuda where you will find trees from all around the world and..... our restaurant, the "Estufa Real" (Royal Green House).

November 4 - Final reception - Xabregas Palace

- Participants and Accompanying Persons

The Open Forum final reception will be held in the impressive Xabregas Palace, that was originally built in the 15th century by order of the famous navigator Tristão da Cunha. It is classified as a national monument with its frescos painted rooms, and glazed tiles from the 16th and 18th centuries.

Upon group's arrival a cocktail will be served in some of the various rooms of the Palace.

Then guests will be lead into the big Tristão da Cunha patee, where they will have dinner.

November 5 - Full-day excursion - optional

For the optional full-day excursion scheduled on Saturday 5 we propose 3 different solutions: A), B/1) and B/2); all destinations are very interesting and well worth a visit.

A) THE MAGIC OF SINTRA AND THE END OF THE CONTINENT

The excursion will start at 9:30. Meeting point: level 1. Transfer by bus.

We will leave Lisbon behind, to discover the beauty and the magical atmosphere of Sintra, a UNESCO World Heritage Site. Its stunning setting on the north slopes of the granite Serra, among wooded ravines and fresh water springs, made it a favorite summer retreat for the kings of Portugal. Downtown Sintra guests will visit the famous Vila Palace with an incredible collection of historical tiles. Finally free time will be left to explore the town and to pop into the several shops or maybe try the delicious cakes known as "queijadas". The tour will continue to the farthest Western point of Europe: the Cabo da Roca. Lunch will be served in a very nice seafood restaurant on the sea side: "Mar do Guincho". After lunch, return to Lisbon driving along the picturesque coastal road and passing by the towns of Cascais and Estoril.

B/1) A BIT OF AUTHENTIC PORTUGAL: ALCOBACA, QUINTA DOS LORIDOS AND OBIDOS

The excursion will start at 9:30. Meeting point: level 1. Transfer by bus.

In the morning we will be directed northeast of Lisbon towards the center of Portugal. After roughly one hour, we will arrive at the Alcobaca Monastery, one of the outstanding architectural monuments of the country. We will continue on to reach the "Quinta dos Loridos" at Bombarral, a truly Portuguese wine producing manor house. Here we will have a wine tasting followed by lunch. In the afternoon transfer to Obidos and time to discover this open air museum. This picturesque Portuguese village in fact was declared world cultural heritage by the UNESCO.

B/2) A BIT OF AUTHENTIC PORTUGAL: FATIMA (AS ALTERNATIVE MORNING PROGRAMME), QUINTA DOS LORIDOS AND OBIDOS

The excursion will start at 9:00. Meeting point: level 1. Transfer by bus.

For people interested in a religious pilgrimage, we propose a visit to Fatima as an alternative programme for the morning. This group would leave a little earlier (bus trip of about 1 hour and a half), then after visiting Fatima would join the rest of the group at the Quinta for lunch and go on with the visit to Obidos.

For this trip to Fatima, a minimum number of 30 participants is requested.

The Saturday excursion will give delegates a further opportunity to come to know each other and discuss matters of mutual interest.

Moreover, by leaving Lisbon on Sunday, delegates may make a substantial saving on air fares!

ADMINISTRATION

VENUE

The Corinthia Alfa Lisboa Hotel • Avenida Columbano Bordalo Pinheiro 1099-031 Lisbon PORTUGAL • Tel. +351 21 7236363 • Fax +351 21 7236364

FEE & PAYMENT in EURO

Fees are clearly stated on the Registration Form and are payable in advance. Forms received without payment cannot be processed.

HOTEL ACCOMMODATION

ENIC will reserve your hotel accommodation and full hotel details will be sent to you with the Registration Confirmation.

Hotel extras should be paid directly to the hotel upon departure.

In addition to payment of the registration fee, full prepayment of the accommodation is required.

CANCELLATIONS, REFUNDS & SUBSTITUTIONS

Cancellation must be requested in writing.

Registration Fee Refunds will be made as follows:

- up to July 22nd. 100% of the registration fee
- between July 23rd. and September 22nd. 50% of the registration fee
- after September 22nd. registrations are considered final and no refunds can be made, but substitutions may be made at any time at no extra charge.

Room cancellation Fee:

- up to July 22, full refund less an administration fee of EUR 30
- between July 23 and September 22, penalty of 75% of the amount of the whole stay
- after September 23, penalty of 100% of the amount of the whole stay
- no-shows and early departures will be charged in full. EUR 30 for administrative expenses will be added.

LIABILITY & INSURANCE

In registering for the Forum, neither FICPI nor ENIC assume any liability whatsoever. Participants are requested to make their own arrangements in respect with health and travel insurance.

In order to secure reservations please send us your form and payment NO LATER THAN September 22, 2005!!

FICPI Open Forum in Lisbon 2005 Programme

THURSDAY 3 NOVEMBER	Trademarks	Patents	General
SESSION 1 - 09:00-10:30			
1.1 TRADE MARK REGISTRATION IN EUROPE Madrid Agreement, Madrid Protocol, Community Trade Mark, National registration - which is to be preferred or is a combination the best course? What circumstances dictate the decision? What are the respective costs? How does one search for conflicting marks? Can a watch be placed on filings for similar marks? The protocol/CTM link has been available for one year now. What is the experience so far? Moderator: Hans-Peter Lieck (DE) Presenters: Petter Rindforth (SE), Elia Sugranes (ES)	2.1 SECRET PRIOR ART This situation sometimes arises where there is an application or patent that has a priority date earlier than a similar application or patent under consideration but is not published at the priority date of the record. Is the second applicant entitled to a patent in any form? What rules apply in relation to novelty and inventive step? What if the earlier is an international application under the PCT but which is in time to but has not yet entered the National Phase? We seem to have moved from the old prior claim situation. What does "whole contents" mean? What is meant by "expanded novelty" in this context? This topic will be explored by experts from the major jurisdictions. Moderator: Gert Schmitt-Nilson (DE) Presenters: Arild Tofting (NO), David Merryless (BR)	3.1 STRATEGIC PLANNING Do you believe your prime focus is servicing domestic clients but spend all your business development budget on international conferences? Do you make a decision at one meeting and a contrary one at the next? Do you hire a new practitioner and then look for clients that match his skill set? Maybe a strategic plan is the answer. When used properly, such a plan will set a road map to ease the day to day management and provide consistency in decision making. The panel will describe the process of developing a plan and how it may be used. Moderator: Mike Kirk (US) Presenters: Markus Hossle (DE), Ed Wesemann (US)	
10:30-11:00 - COFFEE BREAK			
SESSION 2 - 11:00-12:30			
1.2 TRADE MARK OPPOSITION PRACTICE/OUTCOMES Should one oppose or seek revocation of a mark once registered? The position may vary throughout Europe and North America. Does it depend on the basis of the complaint? Our panel will discuss the wisdom of alternative courses of action. What if you will be infringing on registration? Is there a difference between first to file and first to use countries? Moderator: Petter Rindforth (SE) Presenters: Gonçalo de Sampaio (PT), Robert Rippe (US)	2.2 NANOTECHNOLOGY Small but potentially powerful, nanotechnology may be the next evolution in patentable subject matter. What is it about? What different issues arise? What range of traditional technology is involved? Eg. polymers, electronics. Who are the experts? Moderator: Eric Le Forestier (FR) Presenters: Patricia Rae (CA), Alexander Esslinger (DE), Adelhart Kruger (ZA)	3.2 CAREER DEVELOPMENT Professionals are more mobile than in the past. Firm first, family second is no longer an acceptable mantra for the young professional. How do you meet this new reality and set an attractive but realistic career path. Are flexible hours and work at home viable alternatives? What selection criteria do you apply for recruiting and how do you maintain an environment where the grass on your side of the fence is always greenest. Moderator: Leon Allen (AU) Presenters: Peter Perry (GB), Wolthas Bettink (NE)*	
12:30-14:00 - LUNCH			
SESSION 3 - 14:00-15:30			
1.3 TRADE MARK ENFORCEMENT IN CHINA It is one thing to register a trade mark but another to enforce it. China is a huge and somewhat diverse country. Many believe it is difficult to trace the source of counterfeit goods and also difficult to enforce rights without the manufacture moving elsewhere very quickly. Is this true? An expert and experienced panel will explain the position and help us to advise on the issue of counterfeiting in China. Moderator: Ai Ming Lee (SG) Presenters: Ge Bo (CN), Vivien Chan (CN)	2.3 MEDICAL USE CLAIMS It is not uncommon that a pharmaceutical substance developed for one use is found to have another important use. Can a patent be obtained for this? Does it depend on whether this second use is unexpected or could be anticipated given experience with other pharmaceuticals. Can one obtain protection for the separated isomers? Is a pro-drug patentable? How can these be claimed? Many millions are spent in developing new diagnostic methods and equipment. Equipment such as ultrasound, magnetic resonance imaging (MRI) can be patented but what of techniques for diagnosis that do not require new equipment? Are these patentable and should they be? Moderator: Len Svensson (US) Presenters: Anne Schouboe (DK), Elisabeth Thouret-Lemaitre (FR), Douglas Deeth (CA)	3.3 PARTNERSHIP STRUCTURES AND MANAGEMENT Managing a group of professionals has been likened to herding cats. Each partner is an owner, highly entrepreneurial and self motivated. Ultimately difficult decisions must be made to determine relative remuneration, recognition of success, balancing contributions, retirement and even which office to allocate. Different firms deal with this in different ways. Benevolent dictatorship works for some, consensus for others, rigid formulas for yet others. The panel will discuss different approaches to meet this onerous task. Moderator: Danny Huntington (US) Presenters: Nick Dougan (GB); TO BE DETERMINED	
15:30-16:00 - COFFEE BREAK			
SESSION 4 - 16:00-17:30			
1.4 TRADE MARK USE What extent of use is necessary to maintain a trade mark? Is there a need for a geographical spread? Does use by a licensee count? What if an infringement continues unchecked over a period of time? Does it make any difference whether this was known or unknown to the proprietor? Moderator: Andrew Parkes (IE) Presenters: Toni Polson Ashton (CA), Fabrizio Benedetti (IT)	2.4 EXEMPLARY DAMAGES/WILFUL INFRINGEMENT Exemplary damage awards in the US are a significant burden. What can be done to limit the risk? How are they determined? How should negative advice be given? Is the advice discoverable in an action claiming exemplary damages? What interferences can be drawn if privilege is claimed? Moderator: Daniel Alge (AT) Presenters: Willem Schuurman (US), Roderick McKelvie (US), Frank-Erich Hufnagel (DE)	3.4 STAFFING AN IP PRACTICE The IP practice is driven by procedures and paperwork. Appropriate staffing levels and skill sets are required to maintain control of the mountain of paper. What is the role of paralegals, how many secretaries are needed for a professional, how can new technologies help and how does the human resource manager provide training, mentoring and skill upgrading. Moderator: Claus-Michael Mayr (DE) Presenters: Geraldine v Gagyi (AT); TO BE DETERMINED	
FRIDAY 4 NOVEMBER			
SESSION 5 - 09:00-10:30			
1.5 TRADE MARK LICENCES What are the essential elements to include in a trade mark licence? Should there be inspection on quality? a specified term? an ability for the proprietor to cancel the arrangement? joint or sole or exclusive use? Can a common law trade mark (unregistered) be licensed? A panel will examine these issues. Moderator: Miguel O'Farrell (AR) Panel: Judge Michael Fysh QC SC (GB), John Hardaway (US)	2.5 COMPARATIVE CLAIM DRAFTING What are the different techniques in drafting claims for the US and Europe? What are the requirements and how strictly are they enforced? What is meant by the jargon terms "two part claims", "Jepson", "Markush" for example? How would the same language be construed for infringement in the two jurisdictions? Moderator: Axel von Hellfeld (DE) Presenters: Joseph Kolasch (US), Leo Jessen (NL), Robert Katz (US)	3.5 FINANCIAL STRUCTURES Ultimately the cost of providing a service must be related to the fees charged. What is the realistic cost of sending a reminder and where is it recouped? How do you analyse expenditures and equate them with revenues? What information is hidden within the balance sheet and what forensic techniques are available to assist in this analysis? Moderator: Frédéric Galliarde (FR) Presenters: Keith Beresford (GB), W. Pike (GB)	
10:30-11:00 - COFFEE BREAK			
SESSION 6 - 11:00-12:30			
1.6 CERTIFICATION MARKS AND APPELLATIONS OF ORIGIN Is there a difference? What is required for a certification trade mark. What is necessary to maintain the registration. Is it necessary to have competition authorities examine the conditions? What is an appellation of origin? Under what conditions is use allowed? Is this a form of traditional knowledge protection? Are wine making techniques, such as champagne, traditional knowledge and also an appellation of origin? Are cheese or wine making techniques, passed from generation to generation, traditional knowledge? Moderator: Francis Ahner (FR) Presenters: Bastiaan Koster (ZA), John Sutton (US) (EU Commission)	2.6 LOOSE LIPS MAY PREJUDICE PATENTS. ESTOPPEL - DOES PRIVILEGE PROTECT YOU? What is said in the USPTO prosecution is clearly relevant but how relevant is what is said in prosecuting the equivalent application in other countries or in litigating an equivalent patent. Can what you say in other applications, in the same technical area, be taken into account (such as admissions of prior art)? Reporting office activities in other jurisdictions. Moderator: Raymond Stewart (US) Presenters: Wesley Whitmyer (US), Michael Caine (AU), Christof Keussen (DE)	3.6 "THE IP BOUTIQUE IS DEAD, LONG LIVE THE IP BOUTIQUE" Multidisciplinary practices have been heralded as the future for IP but it seems as many fail as succeed. What are the challenges in integrating an IP practice within a larger firm? How do IP firms differ from general law firms, what challenges exist with multi jurisdictional firms to resolve conflicts of ethics and culture? What steps can and have been taken to ensure success in these arrangements? Moderator: Udo Preuss (DE) Presenters: George Fisk (CA); Nathan Cohen-Zedek (IL)	
12:30-14:00 - LUNCH			
SESSION 7 - 14:00-15:30			
1.7 SPARE PARTS How does one protect spare parts? Use of trade marks? What about coverage for original products also capable of being spare parts? What of inferior parts, product liability and warranties? Moderator: Robert Mitchell (CA) Presenters: Greg Chambers (AU), Gerhard Bauer (DE)	2.7 INTERNATIONAL TREATIES The US has entered into Free Trade Agreements with a number of countries such as NAFTA, US-Australia Free Trade Agreement and US-Singapore Free Trade Agreement. Also TRIPS is relevant. What are the enforcement mechanisms to ensure compliance of the parties? To what extent can a country's obligations under International Treaties be used in actions before National Offices where practice is contrary to the Treaty obligations of that country? Moderator: Bill Edgar (CA) Presenters: Adrian Otten, WTO, Jeff Kushan (US), Dr. Jose Arnaut (PT)	3.7 RISK MANAGEMENT Internal operations can create profitable and efficient practices but also introduce potential liabilities. IT is a growth industry requiring continuous supervision and management. File management, or lack thereof, can cause major inefficiencies and email has compounded the problem. How is quality maintained and is a structured quality control system, such as ISO, the answer. What do insurers look for in best practices to mitigate risk? Moderator: Noel Brett (AU) Presenters: Max Carter (US)*	
15:30-16:00 - COFFEE BREAK			
			*To be confirmed